

## **AMENDMENTS TO THE DRAWINGS WITHOUT MARKINGS**

### **IN THE DRAWING:**

Fig. 8 has been amended.

## REMARKS

The last Office Action of July 25, 2006 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1-19 are pending in the application. Claims 7-9, 11, 12, 17-19 have been withdrawn from further consideration. Claims 1, 3, 13 have been amended. Claim 2 has been canceled. No claim has been added. Amendments to the specification have been made. No fee is due.

It is noted that the drawings are objected to because of applicant's failure to show every feature set forth in the claims.

It is further noted that claims 1-6, 10 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 4,571,223 to Molloy. According to a telephonic interview with the Examiner on August 31, 2006, claims 13 and 14 should be considered rejected for the same reasons as applied against claim 1.

Claims 15, 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Molloy in view of U.S. Pat. No. 6,478,701 to Yasuhara et al.

Claims 1-6, 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fig. 21 of Yasuhara et al. in view of Japanese Publ. No. JP 60-19850 (hereinafter "JP ' 850").

## OBJECTION TO THE DRAWING

Applicant has amended Fig. 8 to incorporate a new reference numeral "56" to designate the end surface of the tensioner arm 9, and a new reference numeral "57" to designate the damping element in general. Original reference numeral "2" has been changed to --22--. A new drawing sheet is submitted and labeled

"Replacement Sheet". The specification has been amended to make it consistent with the amendments to the drawing. No new matter has been added.

Claim 1 has been amended to address the ambiguity set forth by the Examiner so as to be consistent with the drawing.

Withdrawal of the objection to the drawing is thus respectfully requested.

#### **REJECTION UNDER 35 U.S.C. §112, SECOND PARAGRAPH**

Applicant has canceled claim 2 and has amended claims 1 and 3 to address the §112 rejection. These changes are self-explanatory and cosmetic in nature and should not be considered as a narrowing amendment to trigger prosecution history estoppel.

Withdrawal of the rejection under 35 U.S.C. §112, second paragraph is thus respectfully requested.

#### **REJECTION UNDER 35 U.S.C. §102(b) AND §103(a)**

In order to clearly set forth the features of the present invention and to more clearly distinguish the present invention from the applied prior art, applicant has amended claims 1 and 13 to expressly set forth the presence of a sliding disk as a damping element and its positional relationship to other components. Support therefore can be found in paragraph [0029] of the instant specification and Fig. 8.

The Molloy reference fails to disclose the presence of a separate damping element in the form of a sliding disk between the tensioner arm and a ring flange, as set forth in claim 1. Molloy merely discloses the arrangement of a cam (34) which is non-turnably attached to the tensioner arm (14) and an elastomer strap (32) which wraps around the cam to provide a damping effect (col. 5, line 63 to col. 5, line 21, col. 7, lines 2-6).

The Yasuhara reference discloses a friction member (436) as damping force producing member which is interposed between a flange of a flanged collar

(435) and the end surface of swing member (406). There is no attachment of the flanged collar to a pin (or peg) for securement of the ring flange as set forth in claim 1.

For the reasons set forth above, it is applicant's contention that neither Molloy nor Yasuhara, nor a combination thereof teaches or suggests the features of the present invention, as recited in claims 1 and 13.

As for the rejection of the retained dependent claims, these claims depend on claims 1 and 13, respectively, share their presumably allowable features, and therefore it is respectfully submitted that these claims should also be allowed.

It should, however, be noted that claims 3, 4 and 14 are further considered allowable on their own merits as they recite other features of the invention neither taught nor suggested by the applied prior art. Claim 3, as amended, recites the presence of an electronic system for controlling the actuator in response to at least one ascertained parameter for adjusting the biasing force of the traction member. In order to bridge the absence of a teaching or suggestion of claim elements of claims 3 and 4, the Examiner makes a broad conclusory statement that this "is inherent for the control unit". Applicant believes that this rejection is improper in the context of the present invention. As stated by the Federal Circuit in *In re Lee*, 61 USPQ2d, 1434, 1435, "Common knowledge and common sense, even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority.". The Court also stated that "The Board's findings must be documented on the record,".

Claim 14 sets forth the presence of an actuator for support of the base on the machine part and for acting on the base for rotation about the rotation axis. The strap (32) which the Examiner equates with the actuator of the present invention fails to provide a support function for the base (cam 34).

Withdrawal of the rejection under 35 U.S.C. §102(b) and §103(a) and allowance of claims 1, 3-6, 10, 13-16 are thus respectfully requested.

## CLARIFICATION AMENDMENT

Applicant has amended the instant specification to consistently use the term "tensioner arm" instead of the alternating use of "tensioner arm" and "pivot arm". These changes are self-explanatory and do not contain any new matter.

## CITED REFERENCES

Applicant has also carefully scrutinized the further cited prior art and finds it without any relevance to the claims on file. It is thus felt that no specific discussion thereof is necessary.

## CONCLUSION

In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

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